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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/552,036

10/03/2005

Toyohisa Fujimoto

Q90347

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SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

ZIMMER, MARC S

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

11/12/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@SUGHRUE.COM
PPROCESSING@SUGHRUE.COM

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/552,036 | Applicant(s) FUJIMOTO, TOYOHISA | |
| | Examiner MARC S. ZIMMER | Art Unit 1796 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 and 4-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwakirii et al., WO 2004011553. To the extent that it evolved from a National stage application of the aforementioned international disclosure, U.S. Patent # 7,473,441 is believed to have an identical disclosure and is used as a faithful translation of the WIPO document into the English language. All citation of teaching location will be those for the U.S. publication. They describe a composition comprising at least those components outlined in the abstract where the silylated oxyalkylene polymer has a number-average molecular weight of between 16,000 and 50,000 (column 8, lines 13-16), is made by ring-opening polymerization of an epoxide in the presence of a double metal cyanide complex (column 5, lines 38-43) and, thus, will inherently possess a polydispersity within the claimed range, and preferably contains 1.2 to 1.6 silicon groups on average where the polymer is linear. Also added to the composition are condensation-curing catalysts (column 14, lines 16-55), fillers, (column 16, lines 26-57), and various other adjuvants.

As for the amount of plasticizer (C), it is appreciated that the permissible range, while it overlaps the range advocated by the claims, is broader than the claimed range by an order of magnitude. Nevertheless, the subject matter as a whole would have

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been obvious to one having ordinary skill in the art at the time the invention was made, since it has been held that choosing the overlapping portion of the range taught in the prior art and the range claimed by the applicant, is *prima facie* obviousness, see *In re Malagari*, 182 USPQ 549.

As for claim 2, it is expected that this condition is satisfied where the amount of plasticizer added corresponds to the low end of the range deemed appropriate by the reference.

Concerning claims 4-15, the Examiner takes notice of the fact that each of the synthetic approaches for appending a silyl group to a polyether defined by these claims is quite familiar to one of ordinary skill in the art of preparing silane-functionalized organic polymers. Indeed, at least most of these techniques are disclosed in one or more of the citations in the first 8 lines of the paragraph bridging columns 9 and 10.

Concerning claim 16, it is stated in column 19, line 1 that phthalate plasticizers may be used in addition to the high molecular weight polyoxyalkylene plasticizer (C).

Response to Arguments

The rejection over Okamoto is hereby withdrawn because it appears that Applicant is indeed correct that they do not fairly suggest a polyether component having the required amount of silicon group content.

The arguments presented in Applicants' September 3, 2009 correspondence, while they also have some bearing on the present rejection, do not serve to obviate this

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rejection. Iwakirii anticipates every aspect of the invention except the limitation pertaining to the amount of surfactant- to the extent that the range of silicon content of the claims and the reference are nearly fully co-extensive, this aspect of the claimed invention is anticipated- and there simply is not enough data showing criticality associated with the claimed range of plasticizer incorporation. Indeed, most of the trials seem to be designed to show what occurs when one operates outside the specified range of silicon group content. It is notable that there is not even a trial where the silicon group content limitation is satisfied while the plasticizer quantity limitation is not though the Examiner believes that more than a single experiment would be needed to augment the existing data in trying to establish an unexpected result.

Due to the new ground for rejection and the fact that the scope of the claims was not really altered in any significant way, this rejection is not being made final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC S. ZIMMER whose telephone number is (571)272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

October 29, 2009

/Marc S. Zimmer/
Primary Examiner, Art Unit 1796